

REMARKS

Reconsideration is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 and 2 of the Office Action

Claims 1-8 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claims 1-8 is therefore respectfully requested.

Paragraphs 3 and 4 of the Office Action

Claims 1-3 have been rejected under 35 U.S.C. §102(b) as being anticipated by Boston 5,743,791.

It is submitted that the Boston reference does not disclose, teach or suggest "said sanding side being for contacting an object to be sanded, said sanding side of said elongate members including an elastic material, said elastic material being fixedly coupled to said sanding side of said elongate members such that said elastic material is positioned between said elongate members and the object being sanded, said elastic material being for selectively coupling sandpaper to such that said elastic material provides a buffer between said sanding side of said elongate members and the object being sanded". The Boston reference teaches a sanding system that fails to teach an elastic material being positioned between the sandpaper and the elongate members to provide buffer between the object being sanded and the elongate members as claimed by the applicant to reduce the effects of heat on the sandpaper and prevent

the elongate members from inadvertently sanding desired subtle changes in curvature flat when the object is being sanded.) Further, the Boston reference teaches away from that claimed by the applicant in that the Boston reference teaches the sanding pad being coupled directly to a rigid structure. Therefore, it is submitted that the Boston reference would not lead one to the combination of features as claimed by the applicant.

Claims 2 and 3 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 3 are also believed to be allowable over the cited reference.

Withdrawal of the §102(b) rejection of claims 1-3 is therefore respectfully requested.

Paragraphs 5 and 6 of the Office Action

Claims 4-8 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Boston in view of Ueno.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

In regards to claims 1 and 8, it is submitted that the combination of Boston with Ueno is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said sanding side being for contacting an object to be sanded, said sanding side of said elongate members including an elastic material, said elastic material being fixedly coupled to said sanding side of said elongate members such that said elastic material is positioned between said elongate members and the object being sanded, said elastic material being for selectively coupling sandpaper to such that said elastic material provides a buffer between said sanding side of said elongate members and the object being sanded". As discussed above, the Boston reference teaches away from an elastic material being positioned between the sandpaper and the elongate members to provide buffer between the object being sanded and the elongate members as claimed by the applicant to reduce the effects of heat on the sandpaper and prevent the elongate members from inadvertently sanding desired subtle changes in curvature flat when the object is being sanded. The Ueno reference teaches a sanding tool that fails to teach an elastic material being positioned between the sandpaper and the elongate members to provide buffer between the object being sanded and the elongate members as claimed by the applicant to reduce the effects of heat on the sandpaper and prevent the elongate members from inadvertently sanding desired subtle changes in curvature flat when the object is being sanded. Further, the sanding tool teaches away from that claimed by the applicant in that the Ueno reference teaches sandpaper being directly coupled to the rigid structures of the base plate and the movable base plates which leads one away from that claimed by the applicant.

Therefore, it is submitted that the Boston reference in combination

Not relied upon for claim

with the Ueno reference would not lead one the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious-- there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Claims 4 through 7 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 4 through 7 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 4-8 is therefore respectfully requested.

VERSION WITH MARKINGS TO SHOW CHANGES MADE:

In the Claims (bracketed parts deleted and underline parts added):

1. (Amended) A set of profiled sanding pads for use in special automotive and other bodywork applications, the set of profiled sanding pads comprising:

 a plurality of elongate members, each of said elongate members having a distinctive configuration;

 said elongate members including main member, said main member having a sanding side and a mounting side;

 said sanding side being for contacting an object to be sanded, said sanding side of said elongate members including an elastic material, said elastic material being fixedly coupled to said sanding side of said elongate members such that said elastic material is positioned between said elongate members and the object being sanded, said elastic material being for selectively coupling sandpaper to such that said elastic material provides a buffer between said sanding side of said elongate members and the object being sanded; and

 said mounting side of said elongate members including a mounting means for mounting said elongate members to an existing sander, said mounting side being for coupling to an existing sander such that a plurality of objects having unique forms are thereby sandable.

2. (Pending) The set of profiled sanding pads as set forth in claim 1, further comprising:

 said main member of a first of said elongate members having a v-shaped cross section, said cross section being perpendicular to a longitudinal axis of said first of said elongate members;

said first of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said first of said elongate members such that said cross section of said first of said elongate members and said mounting plates form an isosceles triangle;

said mounting plates including said mounting means for mounting to the existing sander; and

said sanding side of said first of said elongate members being a side opposite of said mounting side.

3. (Pending) The set of profiled sanding pads as set forth in claim 1, further comprising:

said main member of a second of said elongate members having an arcuate cross section, said cross section being perpendicular to a longitudinal axis of said second of said elongate members;

said second of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said second of said elongate members such that said cross section of said second of said elongate members and said mounting plates being arcuate;

said mounting plates including said mounting means for mounting to the existing sander; and

said sanding side of said second member of said elongate members being a side opposite of said mounting side.

4. (Amended) The set of profiled sanding pads as set forth in claim 3, further comprising:

said main member of a third of said elongate members including a medial section, a first side section, and a second side section, said first and second side sections being on opposing sides

of said medial section, said first and second side sections angling away from said medial section in opposite directions;

 said medial section of said main member including a top surface, said top surface including said mounting means for mounting to the existing sander; and

 said sanding side of said third member being a side opposite said top surface.

5. (Pending) The set of profiled sanding pads as set forth in claim 1, further comprising:

 said main member of a fourth of said elongate members including a medial section, a first side section, and a second side section, said first and second side sections being on opposing sides of said medial section, said side sections angling away from said medial section in a similar direction such that the obtuse angles between said medial section and said side sections are substantially equal;

 said side sections of said main member having a width being substantially equal, said medial section of said main member having a width being substantially greater than said width of said side sections of said main member;

 said fourth of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said fourth of said elongate members such that said cross section of said fourth of said elongate members and said mounting plates form a trapezoid;

 said mounting plates including said mounting means for mounting to the existing sander; and

 said sanding side of said fourth member being a side opposite of said mounting side.

6. (Pending) The set of profiled sanding pads as set forth in claim 1, further comprising:

 said main member of a fifth of said elongate members including a medial section, a first side section, and a second side section, said first and second side sections being on opposing sides of said medial section, said side sections angling away from said medial section in a similar direction such that the obtuse angles between said medial section and said side sections are substantially equal;

 said side sections and said medial section of said main member having a width being substantially equal;

 said fifth of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said fifth of said elongate members such that said cross section of said fifth of said elongate members and said mounting plates form a trapezoid;

 said mounting plates including said mounting means for mounting to the existing sander; and

 said sanding side of said fifth member being a side opposite of said mounting side.

7. (Amended) The set of profiled sanding pads as set forth in claim 1, further comprising:

 said main member of a sixth of said elongate members having a u-shaped cross section, said cross section being perpendicular to a longitudinal axis of said sixth of said elongate members;

 said main member having a rear section, a top section, and a front section, said rear, top and front sections having approximately the same width;

 said rear section including said mounting means, said mounting means protruding outwardly from a u-shaped channel

defined by said rear, top and front sections for being selectively couplable to the existing sander; and

 said sanding surface of said main member being located on an inside surface of said u-shaped channel [such that said inside surface faces a rear surface of said front section, said rear surface being opposite said mounting means].

8. (Amended) A set of profiled sanding pads for use in special automotive and other bodywork applications, the set of profiled sanding pads comprising:

 a plurality of elongate members, each of said elongate members having a distinctive configuration;

 said elongate members including main member, said main member having a sanding side and a mounting side;

 said sanding side being for contacting an object to be sanded, said sanding side of said elongate members including an elastic material, said elastic material being fixedly coupled to said sanding side of said elongate members such that said elastic material is positioned between said elongate members and the object being sanded, said elastic material being for selectively coupling sandpaper to such that said elastic material provides a buffer between said sanding side of said elongate members and the object being sanded;

 said mounting side of said elongate members including said mounting means for mounting said elongate members to an existing sander, said mounting side being for coupling to the existing sander such that a plurality of objects having unique forms are thereby sandable;

 said main member of a first of said elongate members having a v-shaped cross section, said cross section being perpendicular to a longitudinal axis of said first of said elongate members;

said first of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said first of said elongate members such that said cross section of said first of said elongate members and said mounting plates form an isosceles triangle;

 said mounting plates including said mounting means for mounting to the existing sander;

 said sanding side of said first of said elongate members being a side opposite of said mounting side;

 said main member of a second of said elongate members having an arcuate cross section, said cross section being perpendicular to a longitudinal axis of said second of said elongate members;

 said second of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said second of said elongate members such that said cross section of said second of said elongate members and said mounting plates being arcuate;

 said mounting plates including said mounting means for mounting to the existing sander;

 said sanding side of said second member of said elongate members being a side opposite of said mounting side;

 said main member of a third of said elongate members including a medial section, a first side section, and a second side section, said first and second side sections being on opposing sides of said medial section, said first and second side sections angling away from said medial section in opposite directions;

 said medial section of said main member including a top surface, said top surface including said mounting means for mounting to the existing sander; and

said sanding side of said third member being a side opposite said top surface;

 said main member of a fourth of said elongate members including a medial section, a first side section, and a second side section, said first and second side sections being on opposing sides of said medial section, said side sections angling away from said medial section in a similar direction such that the obtuse angles between said medial section and said side sections are substantially equal;

 said side sections of said main member having a width being substantially equal, said medial section of said main member having a width being substantially greater than said side sections of said main member;

 said fourth of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said fourth of said elongate members such that said cross section of said fourth of said elongate members and said mounting plates form a trapezoid;

 said mounting plates including said mounting means for mounting to the existing sander;

 said sanding side of said fourth member being a side opposite of said mounting side;

 said main member of a fifth of said elongate members including a medial section, a first side section, and a second side section, said first and second side sections being on opposing sides of said medial section, said side sections angling away from said medial section in a similar direction such that the obtuse angles between said medial section and said side sections are substantially equal;

 said side sections and said medial section of said main member having a width being substantially equal;

said fifth of said elongate members including a plurality of mounting plates, said mounting plates being fixedly coupled to said mounting side of said fifth of said elongate members such that said cross section of said fifth of said elongate members and said mounting plates form a trapezoid;

 said mounting plates including said mounting means for mounting to the existing sander;

 said sanding side of said fifth member being a side opposite of said mounting side;

 said main member of a sixth of said elongate members having a u-shaped cross section, said cross section being perpendicular to a longitudinal axis of said sixth of said elongate members;

 [said main member having a rear section, a top section, and a front section, said sections having approximately the same width;]

 said main member having a rear section, a top section, and a front section, said rear, top and front sections having approximately the same width;

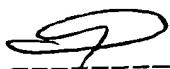
 said rear section including said mounting means, said mounting means protruding outwardly from a u-shaped channel defined by said rear, top and front sections for being selectively couplable to the existing sander; and

 said sanding surface of said main member being located on an inside surface of said u-shaped channel [such that said inside surface faces a rear surface of said front section, said rear surface being opposite said mounting means].

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,



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